

## **REMARKS**

Reconsideration of the Office action mailed on January 22, 2004 in connection with the above-identified patent application is requested in view of the foregoing amendments and the following remarks.

### **Special Circumstances**

The Examiner asked applicant to point out any material information from the co-pending applications listed as parents to the instant application if the criteria for materiality applies and if the examination record provides reason for applicant to believe that the Examiner has not considered such information. Applicant is uncertain what the Examiner is requesting. Applicant has previously identified the applications and believes that identification satisfies its duty of disclosure. Nevertheless, in an attempt to respond to the request, applicant has attached to the end of this document as "Attachment 1" a list of its patent applications and its one Taiwanese patent (the list does not include the national phase filings of the listed PCT application). None of the listed applications have yet issued as patents. The Examiner is requested to inform applicant if further information concerning any of these applications is needed.

### **Double Patenting**

The Examiner stated: "It should be noted that for the purpose of this office action the below rejections under 35 U.S.C. 101 (double patenting) are being made under the assumption that the applications were not commonly owned at the time of applicant's invention." (Office Action, 2.) Applicant is uncertain what the Examiner means by this statement. The double patenting rejections set forth in the Office Action were made under the judicially created doctrine of obviousness-type double patenting, not under 35

U.S.C. 101, so applicant does not understand why reference was made to that statute. Additionally, as far as applicant is aware, obviousness-type double patenting rejections are made between commonly owned applications so applicant does not understand why the assumption was made that the applications were not commonly owned. The Examiner is requested to inform applicant if further information concerning these points is needed.

The Examiner further stated: "Additionally, it should be noted that the below double patenting rejections are based upon known and available co-pending applications and although it is believed that all appropriate rejections have been made, Applicant's help in determining all appropriate double patenting rejections with all of Applicant's applications is requested because of the large number of similar applications." (Office Action, 2.) Applicant is uncertain what help the Examiner is requesting. To the extent the Examiner is asking for identification of applicant's co-pending applications, then, as stated above, applicant has attached to the end of this document a list of its patent applications and its one Taiwanese patent. Additionally, to the extent that applicant is aware of any double patenting issue, applicant will take some action to address or defer the issue, such as by amending or canceling claims, by traversing the rejection, by filing a terminal disclaimer, or by taking some other action. The Examiner is requested to inform applicant if further information concerning this issue is needed.

The Examiner provisionally rejected claims 1-5, 16 and 18 under the judicially created doctrine of obviousness-type double patenting in light of several of applicant's co-pending applications and various other references. Applicant traverses those

rejections because of differences between the claims. Nonetheless, applicant has cancelled claims 1-5, 16 and 18 without prejudice in order to allow other claims to issue and therefore the double patenting rejections are now moot.

**Statement Under 37 CFR 1.78(c)**

The Examiner required applicant under 35 USC §103(c) and 37 CFR 1.78(c) to state whether the inventions claimed in the applications cited as the bases for the double patenting rejections were commonly owned at the time the invention claimed in the present application was made. In response, SD3, LLC states that the inventions claimed in the present application and in the co-pending applications cited by the Examiner were commonly owned or subject to an obligation of assignment to SD3, LLC at the time each later invention was made. The undersigned is authorized to make this statement on behalf of SD3, LLC. By making this statement applicant does not concede that the cited claims are conflicting claims or that the double patenting rejections are proper.

**Claim Rejections – 35 USC §102(f)**

The Examiner rejected claims 1-5, 16 and 18 under 35 U.S.C. §102(f) by saying applicant did not invent the claimed subject matter. Specifically, the Examiner said, "It is not clear who actually invented the subject matter of claims [1-5, 16 and 18] because the above co-pending applications [referring to the co-pending applications cited to support the double patenting rejections] have different inventive entities." (Office Action, 17.) This rejection is traversed.

The inventors named in the present application are the inventors of the subject matter claimed in the present application. Multiple individuals are named as inventors

because each individual made a contribution to the subject matter of at least one claim of the application, even though each individual may not have made the same type or amount of contribution and even though each individual may not have made a contribution to the subject matter of every claim in the application. Different inventive entities are named in a number of the co-pending applications cited by the Examiner because other individuals made contributions to the subject matter of at least one claim of each such application. The fact that inventive entities may be different in various applications does not mean that inventorship is incorrect in the present application. Often applications with overlapping subject matter but with additional disclosures and differing sets of claims have different inventive entities. That is the situation here. The present application and the co-pending applications cited by the Examiner have disclosures and claims that differ and that require the naming of different inventive entities. Thus, there is no inconsistency in inventorship and applicant requests the rejection under 35 U.S.C. 102(f) be withdrawn.

#### **Claim Rejections – 35 USC §103**

The Examiner rejected claims 1-5 and 16-18 under 35 U.S.C. §103(a) as obvious in light of various references. Those rejections are traversed because the cited references fail to show all the limitations of the claims, because there is no teaching, suggestion or motivation to combine the references, and because there is no reasonable expectation that the proposed combinations would be successful. Nevertheless, the rejections are now moot because applicant has cancelled claims 1-5 and 16-18 without prejudice in order to allow other claims to issue.

### **New Claims**

Applicant has added new independent claims 19 and 20. Claim 19 includes the limitation: “reaction means for stopping movement of the pivot arm toward the base assembly upon detection by the detection system of the one or more dangerous conditions, where the reaction means comprises a brace member and locking means for preventing the pivot arm from moving toward the base assembly when the detection system detects the one or more dangerous conditions between a person and the blade; where the brace member is coupled to the tilt mechanism and the locking means; and where the locking means is coupled to the pivot arm.” Claim 20 includes the limitation: “reaction means for stopping movement of the pivot arm toward the base assembly upon detection by the detection system of the one or more dangerous conditions, where the reaction means comprises a brace member and locking means for preventing the pivot arm from moving toward the base assembly when the detection system detects the one or more dangerous conditions between a person and the blade; where the brace member is coupled to the base assembly and the locking means; and where the locking means is coupled to the pivot arm.” These limitations are written in means-plus-function format and therefore must be interpreted under 35 U.S.C. §112 to cover the corresponding structure disclosed in the specification and equivalents. The cited references fail to disclose any such structure or equivalents.

### **Information Disclosure Statement**

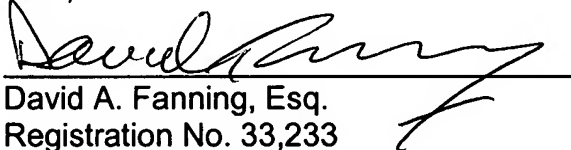
Applicant is submitting an information disclosure statement concurrently with this amendment that identifies UK Patent Application No. 2096844A. That reference was recently cited in one of applicant's co-pending U.S. applications.

### **Conclusion**

With the entry of the above amendments, and for the reasons discussed herein, Applicant submits that all of the issues raised in the Office action mailed January 22, 2004 have been addressed and overcome. If there are any remaining issues or if the Examiner has any questions, applicant's undersigned attorney can be reached at the number listed below. Similarly, if the Examiner believes that a telephone interview might be productive in advancing prosecution of the present application, the Examiner is invited to contact applicant's undersigned attorney at the number listed below.

Respectfully submitted;

SD3, LLC

A handwritten signature in black ink, appearing to read "David A. Fanning", is written over a horizontal line.

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### Attachment 1

<u>Title</u>	<u>Serial No./ Publication No.</u>	<u>Filing Date/ Publication Date</u>
Detection System For Power Equipment	09/929,426 2002-0017176-A1	August 13, 2001 February 14, 2002
Contact Detection System For Power Equipment	60/225,200	August 14, 2000
Apparatus And Method For Detecting Dangerous Conditions In Power Equipment	09/929,221 2002-0017336-A1	August 13, 2001 February 14, 2002
Apparatus And Method For Detecting Dangerous Conditions In Power Equipment	60/225,211	August 14, 2000
Firing Subsystem For Use In A Fast-Acting Safety System	09/929,240 2002-0020263-A1	August 13, 2001 February 21, 2002
Firing Subsystem For Use In A Fast-Acting Safety System	60/225,056	August 14, 2000
Spring-Biased Brake Mechanism For Power Equipment	09/929,227 2002-0020271-A1	August 13, 2001 February 21, 2002
Spring-Biased Brake Mechanism For Power Equipment	60/225,170	August 14, 2000
Brake Mechanism For Power Equipment	09/929,241 2002-0017180-A1	August 13, 2001 February 14, 2002
Brake Mechanism For Power Equipment	60/225,169	August 14, 2000
Retraction System For Use In Power Equipment	09/929,242 2002-0017181-A1	August 13, 2001 February 14, 2002
Retraction System For Use In Power Equipment	60/225,089	August 14, 2000
Replaceable Brake Mechanism For Power Equipment	09/929,236 2002-0020261-A1	August 13, 2001 February 21, 2002
Replaceable Brake Mechanism For Power Equipment	60/225,201	August 14, 2000
Brake Positioning System	09/929,244 2002-0017182-A1	August 13, 2001 February 14, 2002
Brake Positioning System	60/225,212	August 14, 2000
Logic Control For Fast-Acting Safety System	09/929,237 2002-0020262-A1	August 13, 2001 February 21, 2002
Logic Control For Fast-Acting Safety System	60/225,059	August 14, 2000

<u>Title</u>	<u>Serial No./ Publication No.</u>	<u>Filing Date/ Publication Date</u>
Motion Detecting System For Use In A Safety System For Power Equipment	09/929,234 2002-0017178-A1	August 13, 2001 February 14, 2002
Motion Detecting System For Use In A Safety System For Power Equipment	60/225,094	August 14, 2000
Translation Stop For Use In Power Equipment	09/929,425 2002-0017175-A1	August 13, 2001 February 14, 2002
Translation Stop For Use In Power Equipment	60/225,210	August 14, 2000
Translation Stop For Use In Power Equipment	60/233,459	September 18, 2000
Cutting Tool Safety System	09/929,226 2002-0017183-A1	August 13, 2001 February 14, 2002
Cutting Tool Safety System	60/225,206	August 14, 2000
Table Saw With Improved Safety System	09/929,235 2002-0017184-A1	August 13, 2001 February 14, 2002
Table Saw With Improved Safety System	60/225,058	August 14, 2000
Miter Saw With Improved Safety System	09/929,238 2002-0017179-A1	August 13, 2001 February 14, 2002
Miter Saw With Improved Safety System	60/225,057	August 14, 2000
Fast Acting Safety Stop	60/157,340	October 1, 1999
Safety Systems For Power Equipment	09/676,190	September 29, 2000
Fast-Acting Safety Stop (Taiwan)	143466	February 25, 2002
Fast-Acting Safety Stop	60/182,866	February 16, 2000
Safety Systems for Power Equipment (PCT)	PCT/US00/26812	September 29, 2000
Miter Saw With Improved Safety System	10/052,806 2002-0059855-A1	January 16, 2002 May 23, 2002
Miter Saw With Improved Safety System	60/270,942	February 22, 2001
Contact Detection System For Power Equipment	10/053,390 2002-0069734-A1	January 16, 2002 June 13, 2002
Contact Detection System For Power Equipment	60/270,011	February 20, 2001



<u>Title</u>	<u>Serial No./ Publication No.</u>	<u>Filing Date/ Publication Date</u>
Power Saw With Improved Safety System	10/052,273 2002-0059853-A1	January 16, 2002 May 23, 2002
Power Saw With Improved Safety System	60/270,941	February 22, 2001
Table Saw With Improved Safety System	10/052,705 2002-0056350-A1	January 16, 2002 May 16, 2002
Table Saw With Improved Safety System	60/273,177	March 2, 2001
Miter Saw With Improved Safety System	10/052,274 2002-0059854-A1	January 16, 2002 May 23, 2002
Miter Saw With Improved Safety System	60/273,178	March 2, 2001
Miter Saw With Improved Safety System	10/050,085 2002-0056349-A1	January 14, 2002 May 16, 2002
Miter Saw With Improved Safety System	60/273,902	March 6, 2001
Miter Saw With Improved Safety System	10/047,066 2002-0056348-A1	January 14, 2002 May 16, 2002
Miter Saw With Improved Safety System	60/275,594	March 13, 2001
Safety Systems For Power Equipment	60/275,595	March 13, 2001
Miter Saw With Improved Safety System	10/051,782 2002-0066346-A1	January 15, 2002 June 6, 2002
Miter Saw With Improved Safety System	60/279,313	March 27, 2001
Safety Systems for Power Equipment	10/100,211 2002-0170399-A1	March 13, 2002 November 21, 2002
Safety Systems For Power Equipment	60/275,583	March 13, 2001
Router With Improved Safety System	10/197,975 2003-0015253-A1	July 18, 2002 January 23, 2003
Router With Improved Safety System	60/306,202	July 18, 2001
Translation Stop For Use In Power Equipment	09/955,418 2002-0020265-A1	September 17, 2001 February 21, 2002
Translation Stop For Use In Power Equipment	60/292,081	May 17, 2001
Band Saw With Improved Safety System	10/146,527 2002-0170400-A1	May 15, 2002 November 21, 2002
Band Saw With Improved Safety System	60/292,100	May 17, 2001

<u>Title</u>	<u>Serial No./ Publication No.</u>	<u>Filing Date/ Publication Date</u>
Apparatus And Method For Detecting Dangerous Conditions In Power Equipment	10/172,553 2002-0190581-A1	June 13, 2002 December 19, 2002
Apparatus And Method For Detecting Dangerous Conditions In Power Equipment	60/298,207	June 13, 2001
Discrete Proximity Detection System	10/189,031 2003-0002942-A1	July 2, 2002 January 2, 2003
Discrete Proximity Detection System	60/302,937	July 2, 2001
Actuators for Use in Fast-Acting Safety Systems	10/189,027 2003-0005588-A1	July 2, 2002 January 9, 2003
Actuators For Use In Fast-Acting Safety Systems	60/302,916	July 3, 2001
Actuators For Use In Fast-Acting Safety Systems	10/205,164 2003-0020336-A1	July 25, 2002 January 30, 2003
Actuators For Use In Fast-Acting Safety Systems	60/307,756	July 25, 2001
Safety Systems for Power Equipment	10/215,929 2003-0037651	August 9, 2002 February 27, 2003
Safety Systems For Power Equipment	60/312,141	August 13, 2001
Safety Systems For Band Saws	10/202,928 2003-0019341-A1	July 25, 2002 January 30, 2003
Safety Systems For Band Saws	60/308,492	July 27, 2001
Router With Improved Safety System	10/251,576 2003-0056853-A1	September 20, 2002 March 27, 2003
Router With Improved Safety System	60/323,975	September 21, 2001
Logic Control With Test Mode For Fast-Acting Safety System	10/243,042 2003-0058121-A1	September 13, 2002 March 27, 2003
Logic Control With Test Mode For Fast-Acting Safety System	60/324,729	September 24, 2001
Detection System for Power Equipment	10/292,607 2003-0090224-A1	November 12, 2002 May 15, 2003
Detection System For Power Equipment	60/335,970	November 13, 2001


<u>Title</u>	<u>Serial No./ Publication No.</u>	<u>Filing Date/ Publication Date</u>
Apparatus and Method for Detecting Dangerous Conditions in Power Equipment	10/345,630 2003-0131703-A1	January 15, 2003 July 17, 2003
Safety Systems For Power Equipment	60/349,989	January 16, 2002
Brake Pawls for Power Equipment	10/341,260 2003-0140749-A1	January 13, 2003 July 31, 2003
Brake Pawls For Power Equipment	60/351,797	January 25, 2002
Miter Saw With Improved Safety System	10/643,296	August 18, 2003
Miter Saw With Improved Safety System	60/406,138	August 27, 2002
Retraction System And Motor Position For Use With Safety Systems For Power Equipment	60/452,159	March 5, 2003
Table Saws With Safety Systems And Blade Retraction	60/496,550	August 20, 2003
Brake Cartridges For Power Equipment	60/496,574	August 20, 2003
Switch Box For Power Tools With Safety Systems	60/533,598	December 31, 2003
Motion Detection System For Use In A Safety System for Power Equipment	60/496,568	August 20, 2003
Improved Detection Systems For Power Equipment	60/533,791	December 31, 2003
Improved Fence For Table Saws	60/533,852	December 31, 2003
Improved Table Saws With Safety Systems	60/533,811	December 31, 2003
Brake Cartridges And Mounting Systems For Brake Cartridges	60/533,575	December 31, 2003
Improved Table Saws With Safety Systems and Systems to Mount and Index Attachments	60/540,377	January 29, 2004



**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to number (703) 872-9306, attention Examiner Boyer D. Ashley, on the date shown below.

Date: April 21, 2004

  
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